

## **REMARKS**

Claims 1-38 are pending in the application. The Examiner has withdrawn claims 4-8, 15-21, 25-32, and 36-38 from consideration as being drawn to a non-elected invention. Claim 13 is cancelled without prejudice or disclaimer. Claims 1, 9, 12, 22, and 33 are amended. Amendments are supported by the original specification (see below). Claims 39 to 43 are new. New claims are supported by the specification (see for example, Tables 1-4; page 24, lines 3-7; pages 37-40, 64-66; and page 67, lines 9-13). No new matter has been added to the claims. Applicants respectfully request withdrawal of the rejections.

### **Objections to the Specification:**

The Examiner has objected to the use of an HTML coded web link. In response, applicants amend the specification pages 11 and 67 by replacing the HTML code with an article published by Kent *et al.* (Kent WJ, Sugnet CW, Furey TS, Roskin KM, Pringle TH, Zahler AM, Haussler D. The human genome browser at UCSC. *Genome Res.* 2002 Jun;12(6):996-1006), who is known to establish the link. Withdrawal of the objections is requested.

### **Rejections under 35 U.S.C. § 112, first paragraph:**

Applicants thank the Examiner for withdrawal of the rejections to claims 1-3, 9-11, and 22-24 based on our earlier response.

However, on pages 3-7 of the Office Action, the Examiner has rejected claims 1-3, 9-12, 14, 22-24, and 33-35 and alleged that the claims encompasses a broad threshold for amplification and overexpression.

In response, applicants amend claims 1, 9, 12, 22, and 33 for clarity, by adding a "detectable" limit for "increase" or "decrease" in amplification and overexpression, as per specification (see for example, page 67, lines 9-13; page 24, lines 3-7) and as set forth by the instrumental detection limit known in the art.

**Rejections under 35 U.S.C. § 102(b):**

Again, applicants thank the Examiner for withdrawal of the anticipation rejections to claims 12-14 in view of the amendments made to the claims.

However, the Examiner has maintained the rejections to claims 33-35 under 35 USC § 102(b) as allegedly being anticipated by Zacharski *et al.*

The Examiner states that Zacharski *et al.* "disclose immunohistochemical techniques [ ] to study hepsin expression", however, the Examiner has agreed that Zacharski *et al.* do not describe that "hepsin is amplified or overexpressed in tumor [cells] lines compared to normal cells."

Without acquiescing to the propriety of the rejection of the claims 33-35, applicants amend claim 33 for clarity and to expedite the prosecution. Amended claim 33 recites an element that "hepsin is amplified or overexpressed in tumor cells [lines] compared to normal cells", which is not present in Zacharski *et al.* disclosure. The amendment is supported by the specification (see for example, page 7, lines 5-30, and pages 22-23). Therefore, Zacharski *et al.* do not anticipate the claimed invention.

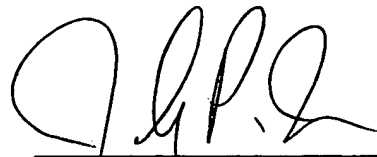
Withdrawal of the rejections is therefore requested.

**CONCLUSION**

In view of this amendment and applicants' remarks above, applicants respectfully submit that claims 1-3, 9-12, 14, 22-24, and 33-35 are allowable, and respectfully request favorable consideration to that effect. The examiner is invited to contact the undersigned at (202) 912-2000 should there be any questions.

Respectfully submitted,

September 27, 2004  
Date

  
\_\_\_\_\_  
John P. Isacson  
Reg. No. 33,715  
Customer No. 26633

Heller Ehrman White & McAuliffe LLP  
1666 K Street, NW, Suite 300  
Washington, DC 20006-1229  
Phone: (202) 912-2000  
Fax: (202) 912-2020